

In re Application of

SPRADLING et al.

Appln. No. 09/358,937

Filed: July 23, 1999



Group Art Unit: 1646

Examiner: J. Andres

TECH CENTER 1600/2900

FOR: METHOD FOR MAINTENANCE AND PROPAGATION  
OF GERMLINE STEM CELLS USING MEMBERS OF THE  
TGF- $\beta$  FAMILY OF GROWTH FACTORS

\* \* \*

November 21, 2000

**REPLY TO RESTRICTION REQUIREMENT AND AMENDMENT**

Hon. Commissioner for Patents  
Washington, D.C. 20231

Sir:

In response to the Office Action (Paper No. 10) mailed on August 29, 2000, Applicants elect with traverse the claims of Group I (claims 1-24, 28-31, 33 and 35-36) for examination. Furthermore, the species listed on page 4 of the Action are elected: 3(b) "*in vivo* methods" and 4(c)(i) "transduction with nucleic acid" and further DPP. Claims 1-2, 4-18, 23-24, 28-31, 33 and 35-36 read on the elected species.

Traversal is on the grounds that the claims of Group I and Group II should be examined together because examination of Group II would necessarily require examination of Group I. The limitations of claim 1 are incorporated into all of the claims of Group II. Thus, it would not constitute an undue burden to examine claims 1-31, 33 and 35-36 in this application because, for example, search and examination of claim 25 would necessarily require search and examination of claim 1.


Applicants respectfully request an explanation for the division of species in ¶4 because they do not appear to be mutually exclusive.

Finally, the Examiner's attention is drawn to the information disclosure state-ments (IDS) submitted by Applicants on December 14, 1999; January 14, 2000; February 16, 2000; and July 28, 2000. Consideration of the information in the IDS and the references cited therein is respectfully requested, along with return of an initialed copy of each Form PTO-1449 to confirm such consideration.

Examination on the merits is earnestly solicited. If any further information is required, the Examiner is invited to contact the undersigned.

Respectfully submitted,

PILLSBURY MADISON & SUTRO, L.L.P.

By   
for Paul N. Kokulis  
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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CP 184565  
PATENT APPLICATION

Group Art Unit 1046  
 Examiner: J. ANDRES  
 Atty. Dkt. PM 254812  
 M#

Client Ref 100/2900  
 Appln. Title: METHOD FOR MAINTENANCE AND  
 PROPAGATION OF GERMLINE STEM  
 CELLS USING MEMBERS OF THE  
 TGF- $\beta$  FAMILY OF GROWTH  
 FACTORS

Inventor(s): SPRADLING et al.  
 Appln. No.: 09 358,937  
 Series Code  $\uparrow$  Serial No.  $\uparrow$

Filed: July 23, 1999

Hon. Commissioner of Patents  
 Washington, D.C. 20231

Sir:

**REPLY/AMENDMENT/LETTER**

Date: November 21, 2000

This is a reply/amendment/letter in the above-identified application and includes the herewith attachment of same date and subject which is incorporated hereinto by reference and the signature below is treated as the signature to the attachment in absence of a signature thereto.

**FEE REQUIREMENTS FOR CLAIMS AS AMENDED**

## 1. Small Entity claim

- A. ☐ NOT made  
 B. ☐ Withdrawn  
 C. ☐ made herewith  
 D. ☒ made previously

For B & C  
 See **Required  
 Separate Paper**  
 (Pat-256)

Claims remaining after amendment	Highest number previously paid for	Present Extra	Large/Small Entity	Additional Fee	Fee Code Lg/Sm
2. Total Effective Claims	36	**minus 36	0	x \$18/\$9 = + \$0	103/203
3. Independent Claims	5	***minus 5	0	x \$80/\$40 = + \$0	102/202
4. If amendment enters proper multiple dependent claim(s) into this application for first time (leave blank if this is a reissue application)..... add				+ \$260/\$130 = + \$0	104/204
5. Original due Date: September 29, 2000	<input type="checkbox"/> NONE				
6. Petition is hereby made to extend the original due date to cover the date this response is filed for which the requisite fee is attached	(1 mo) (2 mos) (3 mos) (Usable only for $\leq$ 2mo.OA --- 4 mos) (Usable only for 30 day/1mo.OA --- 5 mos)	\$110/\$55 = \$390/\$195 = \$890/\$445 = \$1390/\$695= \$1890/\$945=	+ \$195		115/215 116/216 117/217 118/218 128/228
7. Enter any previous extension fee paid since above original due date and subtract		- \$0			
8.				Extension Fee Attached + \$195	
9. If Terminal Disclaimer attached, add Rule 20(d) official fee .....		+ \$110/\$55	+ \$0		148/248
10. If IDS attached requires Official Fee under Rule 97 (c), .....	add	+ \$180	+ \$0		126
or if Rule 97(d) Request .....	add	+ \$180			126
11. After-Final Request Fee per rules 129(a) and 17(r) .....		+ \$710/355	+ \$0		146/246
12. No. of additional inventions for examination per Rule 129(b).....		x \$710/355 ea	+ \$0		149/249
13. Request for Continued Examination (RCE) .....		+ \$710/355	+ \$0		1179/1279
14. Petition fee for .....			+ \$0		
15.				TOTAL FEE ENCLOSED =	\$195

16. \*If the entry in this space is less than entry in next space, the "Present Extra" result is "0".

17. \*\*If the "Highest number previously paid for" in this space is less than 20, write "20" in this space.

18. \*\*\*If the "Highest number previously paid for" in this space is less than 3, write "3" in this space.

Our Deposit Account No. 03-3975)

(Our Order No. 20263 254812

C#

M#

CHARGE STATEMENT: The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficiencies only) now or hereafter relative to this application and the resulting Official Document under Rule 20, or credit any overpayment, to our Accounting/Order Nos. shown above, for which purpose a duplicate copy of this sheet is attached.

This CHARGE STATEMENT **does not authorize** charge of the issue fee until/unless an issue fee transmittal sheet is filed.

Query: Is appeal deadline now? If so, file Notice of Appeals separately.

Pillsbury Madison & Sutro LLP  
 Intellectual Property Group

By Atty: Paul N. Kokulis

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Sig:

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NOTE: File this cover sheet in duplicate with PTO receipt (PAT-103A) and attachments